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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/692,569

10/24/2003

Judith D. Auslander

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7590

02/03/2006

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35 WATERVIEW DRIVE

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EXAMINER

NGUYEN, KIMBERLY D

ART UNIT

PAPER NUMBER

2876

DATE MAILED: 02/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/692,569

Applicant(s)

AUSLANDER ET AL.

Examiner

Kimberly D. Nguyen

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2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2005.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-23 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 11-23 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 9/19/05.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Amendment

1. Acknowledgment is made of Amendment filed October 31, 2005.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 11-18 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 31 of copending Application No. 10/737,006. Although the conflicting claims are not identical, they are not patentably distinct from each other because, for example, in claim 11 of the present claimed invention and claim 31 of application ‘006, the applicant claims:

“A system for printing an indicium on an item, the system comprising: a print head system adapted to print at least two different inks onto the item, the print head system comprising a first supply of a first ink having a first color under normal daylight and a second

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supply of a second different ink, the second different ink having a second color under a normal daylight which is substantially the same as the first color, and wherein the second ink comprises a fluorescent ink;” whereas in the application ‘006, the applicant claims “A system for printing the word processing document of claim 23, the system comprising: a print head system adapted to print at least two different inks on the document, including the first ink and the second different ink;” and

“a controller for controlling application of the first and second inks by the print head system on the item, wherein the controller is adapted to print the first and second inks in at least partially intermixed patterns such that the patterns of the first and second inks are substantially visually indiscernible within the indicium in normal daylight, and the second pattern of the second ink is discernible from the first pattern when subjected to fluorescent-exciting radiation.” whereas in the application ‘006, the applicant claims “a controller for controlling application of the first and second inks by the print head system on the document, wherein the controller is adapted to print the first and second inks such that the first and second inks are visually indiscernible from each other in white light, and the second ink is discernible from the first ink when subjected to fluorescent-excitation radiation.”

Accordingly, with respect to the above discussion, the instant claims obviously encompass the claimed invention of application ‘006.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 11-12, 14, 16-17, 19-20, and 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wright et al. (US 4,864,618; hereinafter "Wright") in view of Bhatt, Bipin G. (EP 900830 A1).

Re claims 11-12, 16-17, 19-20, and 22-23: Wright teaches a system for printing an indicium on an item, the system comprising: a print head system adapted to print at least two different inks onto the item, the print head system comprising a first supply of a first ink having a first color under normal daylight and a second supply of a second different ink, the second different ink having a second color under a normal daylight which is substantially the same as the first color, and wherein the second ink comprises a fluorescent ink (see abstract, lines 7-12); and

a controller ("The printer 40 has a microprocessor unit (printer MPU) 41 which individually and uniquely controls the operation of a print head 42..." col. 8, lines 23-26) for controlling application of the first and second inks by the print head system on the item, wherein the controller is adapted to print the first and second inks in at least partially intermixed patterns such that the patterns of the first and second inks are substantially visually indiscernible within the indicium in normal daylight ("In the invention, an underlying and/or invisible machine readable code is printed first and may then be overprinted with the human readable postmark."

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col. 12, lines 38-40; col. 12, lines 55-58, which is interpreted as partially intermixed patterns), and the second pattern of the second ink is discernible from the first pattern when subjected to fluorescent-exciting radiation (col. 12, line 27 through col. 13, line 50; col. 7, line 40 through col. 9, line 50).

Although, Wright teaches “the code can be printed with ink that is invisible in the normal light spectrum, so that it is readable only with a magnetic, infrared, or ultraviolet reader.” (col. 12, lines 44-47)

Wright does not specifically teach the ink is a fluorescent ink.

Bhatt teaches an invisible ink is a fluorescent ink (see abstract).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the well-known fluorescent ink as taught by Bhatt to the teachings of Wright in order to obscure coded information in the normal light condition.

Re claim 14: Wright teaches the print head 42 prints the coded marks in invisible ink then, in a second pass, prints the visible postmark information (col. 13, lines 23-31).

5. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wright in view of Parkos (US 5,912,682). The teachings of Wright have been discussed above.

Re claim 13: Wright fails to teach or fairly suggest the print head system comprising at least two print heads.

Parkos teaches a print head system comprising a pair of ink jet print heads (42 in fig. 4; col. 4, lines 1-19; col. 6, line 65 through col. 7, line 15).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate a printer system with a pair of print heads as taught by Parkos

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to the teachings of Wright in order to print desired information with unique ink characteristics by using different dedicated print head(s) for each ink, and thus speeding up the processing time when two types of the unique inks are utilized.

6. Claims 15, 18, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wright in view of Soules et al. (US 5,067,713; hereinafter "Soules"). The teachings of Wright have been discussed above.

Wright teaches the invisible machine readable code is printed first and may then be overprinted with the human readable postmark (col. 12, lines 38-40).

Wright fails to specifically teach the second/invisible ink at least partially on top of the first/visible ink.

Soules teaches the invisible ink is overprinted on top of the visible ink (the three diamonds) (Abstract; col. 4, lines 8-23).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the invisible ink on top of the visible ink as taught by Soules to the teachings of Wright in order to provide an invisible code on any surface markings without effecting the face markings. Furthermore, it would have been an obvious expedience/variation to an ordinary to modify Wright's teaching of the invisible code overprinted with the visible code, then flip flop the visible/invisible code to achieve the desired design.

Response to Arguments

7. Applicant's arguments, see pages 6-8, filed October 31, 2005, with respect to the rejection(s) of claim(s) have been fully considered and are persuasive. Therefore, the rejection

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has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Wright, Bhatt, Parkos, and Soules as set forth in the Office action.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly D. Nguyen whose telephone number is 571-272-2402. The examiner can normally be reached on Monday-Friday 7:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on 571-272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



KDN

January 31, 2006